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In re Application of:
Lincoln T. Evans-Beauchamp and
Jeremy Link
Application No. 09/908,984
Filed: July 18, 2001
Title of Invention: DECISION ENGINE:
AND METHOD AND APPLICATIONS THEREOF:

ON PETITION **OFFICE OF PETITIONS**

This is in response to a Request for Reconsideration of Petition to prevent the inventor from obtaining access to the above-identified application file, under the Manual of Patent Examining Procedure ("MPEP") § 106, filed June 14, 2002, which is being treated as a petition under 37 CFR 1.182.

The petition under 37 CFR 1.182 is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.182." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background:

The original petition, filed February 20, 2002, alleged that the present assignee was the assignee of record of the entire interest in the above-identified patent application. In support of that petition, Petitioner filed an Employee Confidentiality and Proprietary Information Agreement ("Agreement"), wherein the inventor for whom the exclusion was sought, Lincoln T. Evans-Beauchamp, agreed to assign, and thereby did assign, his entire right, title and interest, in and to each invention. The Agreement specifically included two technologies, neither of which is the subject of the instant application.

The petition was dismissed because petitioner provided no documentary evidence of a chain of title, in the above-identified application, from the original owner to the assignee.

The instant petition:

Petitioner files the instant Request for Reconsideration wherein Petitioner avers that "the patent assignee is the assignee of record of the entire interest in the above-entitled patent application by virtue of an assignment filed December 31, 2001." The petition "points to the assignment recorded under Reel/Frame No. 012601/0484 on February 12, 2002."

A review of the putative assignment reveals that it is not an assignment of the above-identified application, but is a copy of the Agreement filed with the original petition on February 20, 2002.

Petitioner is directed to *Arachnid, Inc. v. Merit Industries, Inc.* 939 F.2d 1574, 1580 19 USPQ2d 1513, 1518 (Fed. Cir. 1991). There, the court said that "[l]egal title to an invention can pass to another only by a conveyance which operates upon the thing invented after it has become capable of being made the subject of an application for a patent." *Id.* at 1580. The Agreement relied upon by Petitioner does not identify the above-identified application. There is, therefore, a question of ownership and transfer in this application.

As iterated in the Decision Dismissing the February 20, 2002 petition, ownership and transfer questions regarding patents rest, not with this Office, but with state courts. See, *Farmland Irrigation Co., Inc. V. Dopplmaier*, 48 Cal. 2d 208, 308 P.2d 732, 113 USPQ 88 (1957). See, also, *University Patents, Inc. v. Kligman*, 762 F.Supp. 1212, 20 USPQ2d 1401, 1405 (E.D. Pa. 1991).

Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries related to this decision may be directed to Petitions Attorney Derek L. Woods at (703) 305-0014.



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